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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/152,059	00/00/00		S

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HM11/0318

EXAMINER
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RILEY, J

ART UNIT	PAPER NUMBER
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1634

3

DATE MAILED: 03/18/99

Please find below and/or attached an Office communication concerning this application or  
proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/152,059

Applicant(s)

Wengel et al.

Examiner

Jezia Riley

Group Art Unit

1634



☐ Responsive to communication(s) filed on \_\_\_\_\_.

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-140 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-140 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

*Oath/Declaration*

1. The Oath/Declaration is objected to because the Oath or Declaration is missing. Appropriate correction is required.

*Election/Restrictions*

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I Claims 1-49, 137, and 138, drawn to an oligomer; classified in Class 536, subclass 23.1.

Group II Claims 50-59, drawn to an oligomer; classified in Class 536, subclass 22.1.

Group III Claims 60-92, 139, and 140, drawn to a nucleoside; classified in Class 536, subclasses 4.1 and 22.1.

Group IV Claims 93-95, drawn to a method of using a LNA compound for the preparation of an LNA modified oligonucleotide; classified in Class 536, subclass 25.3.

Group V Claims 96 and 97, drawn to a conjugate and method of preparation; classified in Class 536, subclass 22.1.

Group VI Claims 98-100, drawn to a method of using a LNA compound as a substrate; classified in Class 435, subclasses 5, 6, 7.1, 7.2, Class 514, subclasses 1 and 44.

Group VII Claims 101 and 110-114, drawn to a method of using a LNA compound as a therapeutic agent; classified in Class 514, subclasses 1 and 44.

Group VIII Claims 102, 115-128, and 134, drawn to a method of using a LNA compound for diagnostic purposes; classified in

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Class 514, subclass 44.

Group IX Claim 103, drawn to a solid support; classified in Class 523, subclasses 1 and 200.

Group X Claims 104-108, drawn to a method of using a LNA compound in the construction of solid surface; classified in Class 536, subclass 22.1.

Group XI Claim 109, drawn to a method of using a LNA compound in a cleavage of DNA; classified in Class 435, subclasses 6, 7.1.

Group XII Claim 129, drawn to a method of using a LNA compound in a RNA catalytic process; classified in Class 435, subclass 91.31.

Group XIII Claim 130, drawn to a method of using a LNA compound in a binding assay; classified in Class 435, subclass 7.1.

Group XIV Claim 131, drawn to a method of using a LNA compound in the separation of enantiomers; classified in Class 536, subclass 27.12.

Group XV Claims 132 and 133, drawn to a method of using a LNA compound for labelling of cells; classified in Class 435, subclasses 455, 468.

Group XVI Claims 135 and 136, drawn to a method of using a LNA compound for the construction of an oligonucleotide containing fluorophor and quencher; classified in Class 435, subclass 6 and Class 536, subclasses 22.1 and 25.32

3. The inventions are distinct, each from the other because of the following reasons:

Inventions I-V are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other

combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the invention of Group II do not require the invention of Group I or III for patentability. The combination of group I as claimed does not require the particulars of the subcombination of group III as claimed because the subcombination has utility by itself or in other combinations. The subcombination has separate utility such as in-vivo enzymatic inhibitors, for example or the combination of Group IV or V.

Inventions I-XVI are related as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the compounds of Groups I-III can be used in any of the inventions of Group IV -XVI.

4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

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remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jezia Riley whose telephone number is (703) 305-6855. The Examiner may normally be reached Monday through Friday, 0900 - 1700 EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Gary Jones, may be reached at (703) 308-1152.

Any inquiry of a general nature or relating to the status of this application should be directed to the Chemical Matrix Receptionist whose telephone number is (703) 308-0196.

Any necessary fax can be sent to (703) 308-4242.

*Jezia Riley*  
JEZIA RILEY  
PATENT EXAMINER